

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

Claims 14, 16, 19, 22 and 25 are currently being cancelled.

Claims 1, 7, 8, 17, 20 and 23 are currently being amended.

Claims 26-32 are currently being added.

This amendment and reply adds, cancels and amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After adding, canceling and amending the claims as set forth above, claims 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24 and 26-32 are now pending in this application.

Claim Rejections – Prior Art:

In the Office Action, claims 1-4, 7, 8, 14, 16, 17, 20, 22, 23 and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,377,804 to Lintulampi; claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of U.S. Patent No. 6,556,820 to Le et al.; and claims 13, 15, 18, 19, 21 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of U.S. Patent Publication No. 2001/0046863 to Rinne. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

The invention according to claim 1 is directed to a method of establishing UMTS communication between a User Equipment (UE) and a Universal Mobile Telecommunications System (UMTS) network, in which UTRAN parameters are forwarded to the UE via a GSM-type network, and in which the UTRAN parameters comprise a list of at least one potential access node to the UE. The claimed UTRAN parameters which are forwarded to the UE via the GSM-type network are not disclosed, taught or suggested by Lintulampi.

In particular, the Office Action asserts that column 2, lines 37-49 of Lintulampi disclose the claimed UTRAN parameters. Applicants respectfully disagree. Rather, the cited portion of Lintulampi discloses a mobile telecommunication system including two mobile telephone networks. A communication device of Lintulampi can be registered with its home network when the service of the home network is requested, and also the communication device can be registered with the other network when the service of the home network is requested. However, there is no disclosure, teaching or suggestion in Lintulampi that the UTRAN parameters comprise a list of at least one potential access node to the UE.

Therefore, for at least the above reasons, presently pending independent claim 1 is not anticipated by Lintulampi.

Presently pending independent claims 7, 8, 17, 20 and 23 recite similar features to those discussed above with respect to independent claim 1, and thus those independent claims are also not anticipated by Lintulampi.

The dependent claims under rejection are patentable for the specific features recited in those claims, as well as due to their respective dependence on one of the presently pending independent claims, the patentability of which is discussed above.

For example, its rejection of claim 5, the Office Action asserted that Le et al. taught the features recited in claim 5. Applicants respectfully disagree.

Le discloses a MS which provides a list of USIM-IDs and how to manage the multiple USIM-IDs (for example, see column 1 lines 6-8 and column 11, lines 15-18 of Le). In column 2, lines 43-58 of Le, it discloses that USIM-IDs are used for managing multiple subscriptions. Thus, the list of USIM-IDs is a list of subscriptions of a MS, and there is no disclosure or suggestion that the UTRAN parameters comprise a list of at least one potential access node to the UE.

Still further, in Le et al., a MS provides a list of USIM-IDs during a Location Area Update (LAU) using a single message in the form of a LAU REQ signal that includes each of the application USIM-IDs. See column 11, lines 15-18 of Le et al. Column 12, lines 2-10 of Le al. discloses that USIMs can be individually activated/deactivated on a dynamic basis, in which a USIM-ID Add or USIM-ID Delete message is used to signal the addition or deletion of one or more USIM-IDs. This description in Le et al. says nothing about deleting potential links supplied in a list of available links to the UE on which satisfactory communication is

not possible, since the adding and deleting of USIM-IDs as described in Le et al. appears to be done on an MS-selected basis with no detailed description as to the criteria used by the MS in performing that selection.

Accordingly, since Lintulampi does not rectify the above-mentioned deficiencies of Le et al., presently pending claim 1 is patentable over the combination of Lintulampi and Le et al. (whereby Rinne also does not rectify the above-mentioned deficiencies of Le et al.).

As each of the other presently pending independent claims under rejection have been amended in a manner similar to the amendments made to presently pending independent claim 1, those claims are also patentable over the combination of Lintulampi and Le et al. (whereby Rinne also does not rectify the above-mentioned deficiencies of Le et al.).

New Claims:

New claims 26-32 have been added to recite additional features of the present invention that are believed to provide a separate basis of patentability for that claim, beyond the reasons given above for their respective base claims. For example, with respect to new dependent claim 26, the Office Action cites paragraphs 195 and 198 of Rinne against claim 13, whereby these portions of Rinne do not teach or suggest that UTRAN parameters include one or more of Radio Frequency, Radio Link ID, Link Reference, S-RNTI, Transport Format Sets, Transport Format Combination Set and Initial DL Power.

New dependent claim 27 recites switching directly from a mode in which the UE is in communication with a GSM base station to a UMTS diversity mode in which the UE is in communication with a plurality of UMTS access nodes. Such features, which are also recited in new dependent claim 31, are not taught or suggested by the cited art of record, when taken as a whole. New dependent claim 30 recites that the UTRAN parameter information output from the UMTS network tunnels through the GSM-type network without being interpreted or processed in any manner by the GSM-type network. As seen in Figures 4a, 4b, 5a and 5b of Lintulampi, on the other hand, the GSM components do appear to interpret and/or process signals sent between the MS and the UMTS network. See, for example, steps 3, 4 and 5 in Figures 4a and 4b of Lintulampi.

New dependent claim 29 recite steps directed to creation of an updated list of available links for the UE, whereby such steps are not taught or suggested by any of the cited art of record, alone or in combination.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date March 14, 2007

By Phillip J. Articola

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6014
Facsimile: (202) 672-5399

George C. Beck
Registration No. 38,072

Phillip J. Articola
Registration No. 38,819